



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,110	08/15/2001	Nobuo Haino	041465-5118	8429

55694 7590 10/19/2006

DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER

CHOWDHURY, NIGAR

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/929,110	Applicant(s) HAINO ET AL.	
	Examiner Nigar Chowdhury	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on 07/25/2006 have been fully considered but they are not persuasive.

In re page 2, applicants argue on 101 rejection.

In response, the examiner respectfully disagrees. On page 57 of "Interim Guidelines for Examination of Patent Applications for Patent subject Matter Eligibility" has "On the other hand, from a technological standpoint.... Regardless of whether the format is a disk or a signal". There is no where said signal encoded with functional descriptive material is nonstatutory or statutory. In page 50, 2nd paragraph, "Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F. 3d at 1360, 3 USPQ2d at 1759" clearly describe that descriptive material are nonstatutory. Claims are nothing but descriptive material.

In re page 4-5, applicants argue that "the tentative control information described in each of the independent claims of the instant application is not managing control information to any extent. Applicants respectfully submit that the tentative control information described in each of the independent claims of the instant application is information used for forming managing control information".

In response, the examiner respectfully disagrees. By the definition of the "tentative" is "not fully worked out or developed". It means portion of control information

Art Unit: 2621

is tentative control information. Okada et al discloses from col. 14 lines 34-39, that "Information for VOB#1-VOB#3 is recorded in an RTRW.....empty areas in the volume area". Portion of RTRW management file could be tentative control information.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-21 are rejected under 35 U.S.C. 101 because claims are directed to a computer data signal embodied in a carrier wave (air).

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). See MPEP 2106.IV.B.1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

Art Unit: 2621

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1, 4, 7, 10, 12, 15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6148140 by Tomoyuki Okada as set forth in the last office action.

2. Okada teaches an information recording apparatus for recording information in a recordable recording medium (See Fig. 17) in conformity to a recording format for a recording medium for reproduction only (See Col. 76 line 37-42), the recording format defining at least unit recording information (See Col. Line 53-60) and managing control information (See Fig. 4A, 17 (1), Col. 14 line 34-39, Col. 35 line 2, 3), the unit recording information including recording information to be reproduced and reproduction control information for controlling a reproduction mode of the recording information, the managing control information controlling the reproduction of one or a plurality of said unit recording information that include all the limitation recites in claim 1.

- A first recording device (See Fig. 17, Col. 34 line 51) for recording unit recording (See Col. 34 line 61-65) information in recordable recording medium
- A generating device (See Fig. 17, Col. 34 line 50-55) for, after unit recording information is recorded (See Col. 34 line 61-65), generating tentative control information corresponding to the recorded unit recording information (See Fig. 4A, Col. 14 line 34-39. Information for VOB#1 or

could be tentative because after editing the information of VOB#1 can be changed and the VOB#1 information can be changed depends on information of VOB) and being used for forming managing control information later on to record it in (See Fig. 84) recordable recording medium (Col. 14 line 14-17).

- A second recording device (See Fig. 17, Col. 34 line 51) for recording generated tentative control information in the recordable recording medium (See Col. 14 line 14-17) every when unit information is recorded in recordable recording medium.

3. In claim 4, applicant introduces a generating device to manage control information in addition to claim 1. A third recording device (See Fig. 17 (70)) for generating (See Fig. 17 (1, 2, 7, 3)) managing control information by using recorded tentative control information and recording it in recordable recording medium when the recording of recording information in recordable recording medium is terminated (See Fig. 84, Col.94 line 12-67, Col. 95 line 1-8).

4. Okada teaches an information recording method for recording information in a recordable recording medium (See Fig. 17) in conformity to a recording format for a recording medium for reproduction only (See Col. 76 line 37-42), the recording format defining at least unit recording information (See Col. Line 53-60) and managing control information (See Fig. 4A, 17 (1), Col. 14 line 34-39, Col. 35 line 2, 3), the unit recording

Art Unit: 2621

information including recording information to be reproduced and reproduction control information for controlling a reproduction mode of the recording information, the managing control information controlling the reproduction of one or a plurality of said unit recording information that include all the limitation recites in claim 7.

- A first recording process (See Fig. 17, Col. 34 line 51) for recording unit recording (See Col. 34 line 61-65) information in recordable recording medium
- A generating process (See Fig. 17, Col. 34 line 50-55) for, after unit recording information is recorded (See Col. 34 line 61-65), generating tentative control information corresponding to the recorded unit recording information (See Fig. 4A, Col. 14 line 34-39. Information for VOB#1 or VOB#2 is recorded in VOB#1 or VOB#2 information. The information could be tentative because after editing the information of VOB#1 can be changed and the VOB#1 information can be changed depends on information of VOB) and being used for forming managing control information later on to record it in (See Fig. 84) recordable recording medium (Col. 14 line 14-17).
- A second recording process (See Fig. 17, Col. 34 line 51) for recording generated tentative control information in the recordable recording medium (See Col. 14 line 14-17) every when unit information is recorded in recordable recording medium.

5. In claim 10, applicant introduces a generating device to manage control information in addition to claim 7. A third recording process (See Fig. 17 (70)) for generating (See Fig. 17 (1, 2, 7, 3)) managing control information by using recorded tentative control information and recording it in recordable recording medium when the recording of recording information in recordable recording medium is terminated (See Fig. 84, Col.94 line 12-67, Col. 95 line 1-8).

6. Okada shows a recording medium in which a recording control program is recorded capable of being read by a recording computer (See Fig. 17 (1), Col. 1 line 13) an information recording apparatus for recording information in a recordable recording medium (See Fig. 17) in conformity to a recording format for a recording medium for reproduction only (See Col. 76 line 37-42), the recording format defining at least unit recording information (See Col. Line 53-60) and managing control information (See Fig. 4A, 17 (1), Col. 14 line 34-39, Col. 35 line 2, 3), the unit recording information including recording information to be reproduced and reproduction control information for controlling a reproduction mode of the recording information, the managing control information controlling the reproduction of one or a plurality of said unit recording information that include all the limitation recites in claim 12.

- A first recording device (See Fig. 17, Col. 34 line 51) for recording unit recording (See Col. 34 line 61-65) information in recordable recording medium

Art Unit: 2621

- A generating device (See Fig. 17, Col. 34 line 50-55) for, after unit recording information is recorded (See Col. 34 line 61-65), generating tentative control information corresponding to the recorded unit recording information (See Fig. 4A, Col. 14 line 34-39. Information for VOB#1 or VOB#2 is recorded in VOB#1 or VOB#2 information. The information could be tentative because after editing the information of VOB#1 can be changed and the VOB#1 information can be changed depends on information of VOB) and being used for forming managing control information later on to record it in (See Fig. 84) recordable recording medium (Col. 14 line 14-17).
- A second recording device (See Fig. 17, Col. 34 line 51) for recording generated tentative control information in the recordable recording medium (See Col. 14 line 14-17) every when unit information is recorded in recordable recording medium.

7. In claim 15, applicant introduces a generating device to manage control information in addition to claim 12. The recording control program causes the recording computer to further function as a third recording device (See Fig. 17 (70)) for generating (See Fig. 17 (1, 2, 7, 3)) managing control information by using recorded tentative control information and recording it in recordable recording medium when the recording of recording information in recordable recording medium is terminated (See Fig. 84, Col.94 line 12-67, Col. 95 line 1-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2, 3, 5, 8, 9, 11, 13, 14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6148140 to Tomoyuki Okada, in view of U.S. Patent No. 6501727 to Mitsuyuki Nozaki as set forth in the last office action

9. Claim 2, 3 introduces recording of reproduction of control information to the combination of claim 1. Okada teaches a first recording device which records the recording information and second recording device which records tentative control information. Okada fails to teach recording of reproduction control information after recording information is recorded; tentative control information is recorded between recording information and reproduction control information.

Nozaki teaches (in Col. 9 line 58-62) after recording information is recorded in a first recording device, records reproduction control information corresponding to the recording information in an area on recordable recording medium, and also area detected ahead of the recording information (See Col. 1 line 62-64); second recording device records tentative control information in an area on recordable recording medium, area located between the area in which recording information is recorded and the area in which reproduction control information is recorded (See Col. 6 line 25-28. Nozaki

said information can be recorded in any order so it could be the order applicant claimed).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have recording of reproduction control information after recording information is recorded; tentative control information is recorded between recording information and reproduction control information.

10. Claim 3 introduces editorial device and generating device to the combination of claim 2. An editorial device is disclosed in Tomoyuki Okada (See Col. 1 line 11-15) for carrying out the editorial processing to change the reproduction content of recording information which has been already recorded in recordable recording medium (See Col. 3 line 64-67, Col. 4 line 1-18).

- Generating device is disclosed in Tomoyuki Okada (See Fig. 17 (1, 2, 7, 3)) newly generates tentative control information corresponding to the content of recording information after the editorial processing; and
- Second recording device is disclosed in Tomoyuki Okada (Fig. 17 (70)) records newly generated tentative control information in a vacant area on recordable recording medium (See Col. 14 line 34-39).

11. In claim 5, applicant introduces a third recording device in addition to claim 4. Okada teaches a third recording device records (See Fig. 17 (70)) generated managing control information in an area on recordable recording medium. Okada fails to teach the

Art Unit: 2621

area detected ahead of the unit recording information. Nozaki teaches (in Col. 9 line 58-62) area is reserved before recording. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a area reservation before records the recording information in the recording medium.

12. Claim 8, 9 introduces recording of reproduction of control information to the combination of claim 7. Okada teaches a first recording process which records the recording information and second recording process which records tentative control information. Okada fails to teach reproduction control information which records after recording information is recorded; tentative control information which records between recording information and reproduction control information.

Nozaki teaches (in Col. 9 line 58-62) after recording information is recorded in a first recording process, records reproduction control information corresponding to the recording information in an area on recordable recording medium, and also area detected ahead of the recording information (See Col. 1 line 62-64); second recording process records tentative control information in an area on recordable recording medium, area located between the area in which recording information is recorded and the area in which reproduction control information is recorded (See Col. 6 line 25-28. Nozaki said information can be recorded in any order so it could be the order applicant claimed).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have recording of reproduction control information

after recording information is recorded; tentative control information is recorded between recording information and reproduction control information.

13. Claim 9 introduces editorial process and generating process to the combination of claim 8. An editorial process is disclosed in Tomoyuki Okada (See Col. 1 line 11-15) for carrying out the editorial processing to change the reproduction content of recording information which has been already recorded in recordable recording medium (See Col. 3 line 64-67, Col. 4 line 1-18).

- Generating process is disclosed in Tomoyuki Okada (See Fig. 17 (1, 2, 7, 3)) newly generates tentative control information corresponding to the content of recording information after the editorial processing; and
- Second recording process is disclosed in Tomoyuki Okada (Fig. 17 (70)) records newly generated tentative control information in a vacant area on recordable recording medium (See Col. 14 line 34-39).

14. In claim 11, applicant introduces a third recording process in addition to claim 10. Okada teaches a third recording process records (See Fig. 17 (70)) generated managing control information in an area on recordable recording medium. Okada fails to teach the area detected ahead of the unit recording information. Nozaki teaches (in Col. 9 line 58-62) area is reserved before recording. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

have an area reservation before records the recording information in the recording medium.

15. Claim 13, 14 introduces recording of reproduction of control information to the combination of claim 12. Okada teaches a first recording device which records the recording information and second recording device which records tentative control information. Okada fails to teach recording of reproduction control information after recording information is recorded; tentative control information is recorded between recording information and reproduction control information.

Nozaki teaches (in Col. 9 line 58-62) after recording information is recorded in a first recording device, records reproduction control information corresponding to the recording information in an area on recordable recording medium, and also area detected ahead of the recording information (See Col. 1 line 62-64); second recording device records tentative control information in an area on recordable recording medium, area located between the area in which recording information is recorded and the area in which reproduction control information is recorded (See Col. 6 line 25-28. Nozaki said information can be recorded in any order so it could be the order applicant claimed).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have recording of reproduction control information after recording information is recorded; tentative control information is recorded between recording information and reproduction control information.

16. Claim 14 introduces editorial device and generating device to the combination of claim 13. The recording control program causes the recording computer (See Fig. 17 (1), Col. 1 line 13) to further function as an editorial device is disclosed in Tomoyuki Okada (See Col. 1 line 11-15) for carrying out the editorial processing to change the reproduction content of recording information which has been already recorded in recordable recording medium (See Col. 3 line 64-67, Col. 4 line 1-18).

- Generating device is disclosed in Tomoyuki Okada (See Fig. 17 (1, 2, 7, 3)) newly generates tentative control information corresponding to the content of recording information after the editorial processing; and
- Second recording device is disclosed in Tomoyuki Okada (Fig. 17 (70)) records newly generated tentative control information in a vacant area on recordable recording medium (See Col. 14 line 34-39).

17. In claim 16, applicant introduces a third recording medium in addition to claim 15. Okada teaches a third recording device records (See Fig. 17 (70)) generated managing control information in an area on recordable recording medium. Okada fails to teach the area detected ahead of the unit recording information. Nozaki teaches (in Col. 9 line 58-62) area is reserved before recording. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a area reservation before records the recording information in the recording medium.

Art Unit: 2621

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6501727 to Mitsuyuki Nozaki, in view of U.S. Patent No. 6553180 to Shinichi Kikuchi.

Nozaki teaches recording format based on a DVD video standard (Col. 1 line 32), recordable recording medium is a DVD-R (Col. 6 line3). Nozaki fails to teach VTSI and VMGI. Kikuchi teaches VTSI (video title set information) in Fig. 4Col. 11 line 17-19. Kikuchi also teaches VMGI in Fig 5, Col. 12 line35-38, Col. 49 line 66, 67, Col. 50 line 1, 2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have VTSI and VMGI in a recording format to record control information.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

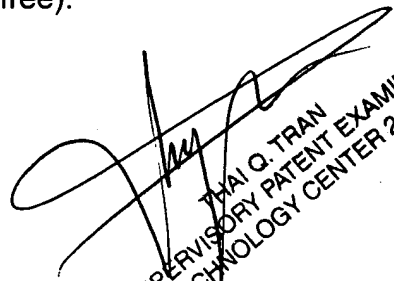
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nigar Chowdhury whose telephone number is 571-272-8890. The examiner can normally be reached on 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC
10/11/06



THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600